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Jeffrey L. Streets Suite 355 13831 Northwest Freeway Houston, TX 77040			EXAMINER ENGLAND, DAVID E	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIA AZUA HIMMEL, HERMAN RODRIGUEZ,
NEWTON JAMES SMITH JR., and CLIFFORD JAY SPINAC

Appeal 2007-3455
Application 10/047,004¹
Technology Center 2100

Decided: August 11, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON, and JAY P. LUCAS,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION VACATED

The decision in this appeal dated March 31, 2008, is hereby *sua sponte* VACATED as certain claims were adjudicated in error. The Examiner had indicated in the Examiner's Answer mailed February 23, 2007

¹ Application filed January 16, 2002. The real party in interest is International Business Machines Corporation of Armonk, N.Y.

that claims 2 to 14, 16, 19 to 30 and 32 to 44 were no longer subject to rejection. Claims 1, 15, 17, 18 and 31, remained on appeal to this Board. The following decision is substituted for the vacated decision.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 to 44 under authority of 35 U.S.C. § 134. (Brief, page 1). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). In consideration of Examiner's statement in the Examiner's Answer mailed February 23, 2007, page 3, only claims 1, 15, 17, 18 and 31 remain subject to this appeal.

Appellants' invention relates to a method, system and computer program for sending an Internet Universal Resource Locator (URL) to customer by e-mail. In the words of the Appellants:

The present invention provides a method for a telephone system to send an electronic message containing a Uniform Resource Locator (URL) to a customer's address. The method includes receiving a telephone call having a customer identification record including a destination address, selecting one or more URL's to be sent to the destination address, generating and sending an electronic message containing the one or more selected URL's, to the destination address. Preferably, the URL is selected to be responsive to an inquiry made during the telephone call. The electronic message may contain additional items other than the selected URL's, including, for example, electronic coupons, an on-line trial subscription, user ID's, user

passwords, advertisements, sender information, or combinations thereof, wherein the user ID's and user passwords are required by the Websites having the addresses of the URL's. The method may further include recording the one or more URL's into the bookmark section of the communications terminal's browser.
(Spec., 2, ll. 10-21).

Claim 1 is exemplary:

1. A computer implemented method for providing a Uniform Resource Locator (URL) to a customer, comprising:
receiving a customer identification record including a destination address associated with a communications terminal of the customer during a telephone call with the customer;

selecting at least one URL to be sent to the destination address of the customer; and

generating and sending an electronic message containing the at least one URL to the destination address of the customer.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Clapper	US 2003/0026403 A1	Feb. 6, 2003 (filed Aug. 2, 2001)
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Rejection:

Claims 1, 15, 17, 18 and 31 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Clapper.

Groups of Claims:

Consistent with the arguments in the Brief, in consideration of the objection in the Examiner's Answer discussed above, we consider the following groups of claims.

Group I: Claim 1 is representative of claims 1, 15, 18, and 31.

Group II: Claim 17 (claim 18, placed by the Appellants in this group, is considered in Group I as it contains the same limitations as claim 1, adapted for a computer program product).

Appellants contend that the claimed subject matter is not anticipated by Clapper for failure of that reference to recite claimed elements. The Examiner contends that each of the groups of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We affirm.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The issue turns on whether all the claimed elements are present in the reference Clapper.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method, system and program (method) to provide a URL to a caller to avoid his having to carefully write down that web address during the phone call. (Spec., 1, l. 25). The method derives from a caller's caller ID information, or orally from the caller himself, a destination address to send the URL by e-mail or by other electronic messaging. (Spec., 2, l. 10).
2. Clapper teaches an improved telephone answering machine capable of recording messages from a caller and sending them as audio files in an electronic message to the user, for example, when he is away from the house. (§ [0020], [0022]). While the caller is leaving a message, the system notes the caller's caller ID information, goes out to the Internet and finds information about the caller, such as his e-mail address, street address, URL of his website, etc. (§ [0021], [0026]). This information is included in the electronic message (which may be an e-mail) to the user. (*Id.*).

PRINCIPLES OF LAW

“In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states that "the words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

However, our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejection of Appellants' claims under 35 U.S.C. § 102. The prima facie case is presented on pages 4 to 8 of the Examiner's Answer.

In opposition, Appellants present a number of arguments. We will address the arguments in accordance with the grouping defined above.

Group I: Claim 1 is representative of claims 1, 15, 18, and 31.

Appellants argue that Clapper fails to disclose sending a URL to the destination address of the customer. (Br., 6, bottom). In Clapper, the system receives various information about the caller from the Internet during a telephone call with the caller. (§ [0021]). That information includes the caller's street address, e-mail address, and so forth. (*Id.*) This information may also include the uniform resource locator (URL) of the caller's website. (§ [0026]). That information, including the URL, is sent electronically to the caller. (*Id.*). The electronic message may be an e-mail. (§ [0022]). While we recognize that the intent of the Appellants' invention is different from the purpose of the Clapper machine, we must read the claims fairly and broadly at the USPTO, considering whether the claimed elements are present in the reference. (See *Philips* cited above.) In interpreting this claim, we note that the caller is read on the customer, who may also be the owner of the device

in Clapper. On that basis, we find that the Examiner has not erred in rejecting these claims under 35 U.S.C. § 102(e), and Appellants have not shown error in the Examiner's rejection.

Group II: Claim 17

Appellants contend that the reference does not teach “‘receiving an e-mail message containing the at least one *URL* from a telephone system of the sender’ (claim 17)” (Br., 13, middle). Actually, Appellants are mistaken: claim 17 does not recite “e-mail” but rather recites “an electronic message.” We note ¶ [0026] of Clapper teaches a web page sent to the user of the system, who may be the first party, which message includes at least one URL. The destination address is provided by the system during a phone call from the first party to the sender. (¶ [0021]). Thus, we do not find that Appellants have shown error with the Examiner's rejection of claim 17.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1, 15, 17, 18 and 31.

DECISION

The Examiner's rejection of claims 1, 15, 17, 18 and 31 is Affirmed.

Appeal 2007-3455
Application 10/047,004

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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